

Docket No.: 057042-0024



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 20277
Gang YANG, et al.	:	Confirmation Number: 6844
Application No.: 09/729,694	:	Group Art Unit: 2634
Filed: December 06, 2000	:	Examiner: S. C. Pathak
For: SECTORIZED SMART ANTENNA SYSTEM AND METHOD	:	

**PETITION FOR EXERCISE OF SUPERVISORY AUTHORITY
AND WITHDRAWAL OF PREMATURE FINALITY OF OFFICE ACTION**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the Director exercise supervisory authority and instruct the Examiner to withdraw the improper finality of the March 10, 2005 Office Action regarding the above identified application. A detailed explanation of the basis of this request is set forth in the remarks, below.

04/13/2005 SZEWDIE1 00000064 500417 09729694

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REMARKS

Applicants submit that the Examiner improperly designated the latest Office Action as final. In the statement of finality (Office Action page 15, section number 8), the Examiner cited M.P.E.P. § 706.07(a) as the basis for making the present Office Action final and stated: “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action.

However, M.P.E.P. § 706.07(a) clearly states:

Furthermore, a second or any subsequent action on the merits in any application. ... **will not be made final** if it includes a rejection, **on newly cited art** ... of any claim not amended by applicant or patent owner **in spite of the fact that other claims may have been amended to require newly cited art.** (emphasis added)

The Examiner withdrew the previous allowability of claim 27 and rejected that claim over art, for the first time in the final Action. The rejection of claim 27 applied newly cited US patent no. 5,952,963 to Shen et al. The rejection of claim 27 also applied US patent no. 5,023,900 to Tayloe et al., which had not been cited in any rejection in either of the previous Actions even though that patent was made of record as early as Applicants’ May 30, 2001 information disclosure statement.

Claim 27 was amended in Applicants’ October 18, 2004 response, but that change did not necessitate the new ground of rejection. A single word was changed in the preamble, to improve consistency thereof with the body of the claim. The amendment, to change “map” to “profile,” could not have changed the scope of the claim, because the claim already referred to “the cell-site signal coverage **profile**” in the last paragraph. Hence, the amendment could not possibly have necessitated the withdrawal of allowability of claim 27 or the new art rejection.

Under M.P.E.P. § 706.07(a), the amendment of other claims in the response is not sufficient to make the latest Office Action final. The finality of the March 10, 2005 Office Action therefore should be withdrawn.

An amendment of the application is filed concurrently herewith. Upon withdrawal of the premature finality of the latest Office Action, that amendment should be entered as a matter of right, and prompt favorable reconsideration is solicited.

Petition Fee/Request for Refund

Please charge the petition fee of \$130.00 (37 C.R.F. § 1.17(h)) to Deposit Account 500417. However, in view of the impropriety of the finality, it is believed that the need for this petition arose from a clear error on the part of the Office and through no fault of Applicants. As such, Applicants respectfully request refund of the petition fee. The refund should be credited to said Deposit Account 500417.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Keith E. George
Registration No. 34,111

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Date: April 12, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**



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 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is an Amendment in the above-identified application.

- ☒ No additional fee is required.
☐ Applicant is entitled to small entity status under 37 CFR 1.27
☒ Also attached: Petition for Exercise of Supervisory Authority and Withdrawal of Premature Findings of Office Action


The fee has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims	5	29	0	\$50.00 =	\$0.00
Independent Claims	3	8	0	\$200.00 =	\$0.00
Multiple dependent claims newly presented					\$0.00
Fee for extension of time					\$0.00
Petition for Exercise of Supervisory Authority					\$130.00
Total of Above Calculations					\$130.00

- ☒ Please charge my Deposit Account No. 500417 in the amount of \$130.00. An additional copy of this transmittal sheet is submitted herewith.
- ☒ The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment, to Deposit Account No. 500417, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


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